

UNITED STATES PATENT AND TRADEMARK OFFICE

BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Ex parte ROBERT SKVORECZ

Appeal 2006-1989
Application 09/772,278
Patent 5,996,948
Technology Center 3600

Decided: November 19, 2007

Before BRADLEY R. GARRIS, *Administrative Patent Judge*, and
FRED E. McKELVEY, *Senior Administrative Patent Judge* and
ALLEN R. MACDONALD, *Administrative Patent Judges*.

MACDONALD, *Administrative Patent Judge*.

DECISION ON REQUEST FOR REHEARING

Appellant requests that we reconsider our Decision of March 28, 2007. We have reconsidered our Decision in light of Appellant's comments in the Request for Rehearing, and we find no error therein. We, therefore, decline to make any changes in our prior Decision for the reasons which follow.

1 Appellant initially contends that the Board erred in its construction of claim 1 and application of the Buff reference as (a) each and every wire leg in the chafing stand of claim 1 (not selected wire legs) must include an offset and (b) only wire legs 49 of the Buff reference include the required offset as lateral leg 48 fails to include an offset. (Reh'g 3-5). We disagree.

Appellant's contention fails on two points. Firstly, the claim language, "wire chafing stand . . . having at least two wire legs with each wire leg having [an offset]," may be open to Appellant's construction, but is also open to the broader construction given to it by this Board. The language does not preclude a third wire leg that does not include an offset. Further, while Appellant's specification shows several embodiments where each and every wire leg has an offset, Appellant does not cite nor do we find this each and every leg structure set forth in the specification as a requirement for the invention. Secondly, Appellant has misconstrued the Buff reference. Buff's horizontal transverse member 48 is not a wire leg. Appellant's own specification states that "wire legs . . . function as bottom supports to keeps the stand level with the ground" (col. 1, ll. 20-21). As shown in Buff's figure 2, horizontal transverse member 48 rests on the two horizontal longitudinal members 49. Only members 49 are legs within the meaning of Appellant's claim 1.

Appellant contends that the Board erred in that the offsets 52 in Buff are passive elements (merely performing a static lateral displacement) and cannot perform the function of lateral displacement (a dynamic lateral displacement), i.e., Appellant contends the claimed offsets are functional elements. Appellant argues that his offsets can respond to a wedging force,

and thus differ from the offsets of Buff which are not designed to be displaced laterally, cannot move laterally, and cannot perform the function of laterally displacing (Reh'g 6). We disagree.

Contrary to Appellant's contention, nothing in Appellant's specification supports the view that his claimed offset is anything more than a passive static structural element. Appellant's offset is disclosed as follows:

[E]ach wire leg having an indent (hereinafter "offset") located adjacent the upper end thereof which laterally displaces each leg relative to the point of attachment of said leg with the upper rim of the stand so that the wire legs of one wire stand can substantially nest within another wire stand without significant wedging.

(Spec., col. 2, 7-12). Appellant's new dynamic functional interpretation of the claimed offset is not supported by this language or any other language in Appellant's specification.

Appellant contends that the Board erred because the terms "offset" and "laterally displacing" are defined by Appellant's specification and the specification does not use the terms "sideways," "long axis," or "short axis" to further limit the lateral displacement (Reh'g 7-8). We disagree.

While Appellant is correct with respect to the contents of his specification, he overlooks that he was the one that argued that his invention differed from Buff in that Buff only teaches an offset at the "longitudinal" ends (App. Br. 8) as opposed to Appellant's "lateral" displacement. Longitudinal and lateral differ in that one is the "long axis" and the other is the "short axis." Since Appellant now admits that no such distinction was

disclosed in his specification, we find no error in our original conclusion that this argument in Appellant's Brief fails to show that the Examiner erred.

Appellant contends that the Board erred in rejecting claim 5 under 35 U.S.C. § 112, second paragraph. Appellant argues the claim 5 limitation "wherein said plurality of offsets are welded to said wire legs at the separation of the upright sections into segments" is clear because "the operation of welding forms welded joints in the wire legs at the intersection of each offset and each wire leg at a location along the wire legs which, in accordance to its plain meaning, divide or separate the upright sections of the wire legs into segments" (Reh'g 9). We disagree.

We would agree with Appellant's argument if claim 5 recited "welded to said wire legs to form a separation," (i.e. the separation does not yet exist). However, the claim recites "welded to said wire legs at the separation" and the language "at the separation" indicates that the separation already exists prior to the welding. This contradicts Appellant's explanation.

Appellant contends that the Board's rejection of claims 1-5 and 7 under 35 U.S.C. § 112, first paragraph, based on inoperability is misplaced. (Reh'g 10).

Contrary to Appellant's argument, no such rejection was made. Rather, the rejection referred to by Appellant is a written description rejection based on the fact that Appellant's figures 12 and 13 (as filed) show a first species of upper rim offset and the claims recite a second species of upper rim offset that is not found in the application as filed. The claimed second species of upper rim offset requires that the upper rim offset laterally

displace the wire leg structurally (as discussed *supra*). The offsets in figures 12 and 13 are Appellant's only originally filed disclosure of upper rim offsets and they do not structurally laterally displace the wire legs as is now claimed. As Appellant correctly notes, "the description in the specification does not even mention a direction for the offsets" (Reh'g 10). This admission confirms that the only disclosed upper rim offset direction is that of figures 12 and 13.

Lastly, Appellant contends the Board erred in that claim 5 does not require that the offsets need be located in the rim. We disagree.

On its face claim 5 depends from claim 1, and limits both embodiments recited in claim 1. Thus, as stated in our decision, "Claim 5 recites a further limitation of the offsets in the rims."

OTHER ISSUES

Appellant indicates that he "has presented evidence which rebuts the *prima facie* case of anticipation and clearly supports the conclusion that the prior art product Buff does not inherently possess the characteristics of the claimed product" (Reh'g 12, emphasis omitted). We find no such evidence in the record. Nor would any such evidence be considered by this Board if presented at this time. *See* 37 C.F.R. § 41.33(c).

Even when proper after the date of filing of an appeal, such evidence is only permitted pursuant to the reopening of prosecution under §§ 41.39(b)(1), 41.50(a)(2)(i) and 41.50(b)(1). Rather than reopening prosecution under 37 C.F.R. § 41.50(b)(1), Appellant has alternatively

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selected to request rehearing under 37 C.F.R. § 41.50(b)(2). Thus, Appellant is now precluded from presenting new evidence.

CONCLUSION

Based on the foregoing, we have granted Appellant's request to the extent that we have reconsidered our Decision of March 28, 2007, but we deny the request with respect to making any changes therein.

No time period for taking any subsequent action in connection with this appeal may be extended under 37 C.F.R. § 1.136(a)(1)(iv).

REHEARING DENIED

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